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No. 02-46

IN THE

Supreme Court of the United States

JBL, INC. AND INFINITY SYSTEMS CORPORATION,
Petitioners,

v.

BOSE CORPORATION,
Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

REPLY IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

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This Reply is necessitated by certain misstatements of fact and of law in the Opposition filed by Respondent Bose Corporation ("Bose"). Bose filed its Opposition by Express Mail on July 18, 2002 and served JBL by regular U.S. mail. JBL did not receive Bose's Opposition until July 26, 2002.

ARGUMENT

I. BOSE AMENDED THE CLAIM LIMITATION AT ISSUE AT LEAST FIVE TIMES BEFORE RESORTING TO THE NARROW DEFINITION OF THAT LIMITATION CONTAINED IN ORIGINAL CLAIM 2

Bose asserts that the claim limitation at issue—the specific shape of the loudspeaker port—was not narrowed during prosecution. Bose is simply wrong. Bose made at least five narrowing amendments to the port-shape limitation in its attempt to obtain allowance of original claim 1. The successive narrowing amendments to original claim 1 are shown in relevant part below:[1]

Application as filed:

> the region outside said enclosure having a smoothly flared input end within said inside volume and a smoothly flared output end adjacent to the region outside said inside volume.

[Pet. App. 78a, 102a].

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[1] The amendments to the port-shape limitation of original claims 1 and 2 are shown using traditional underlining and brackets. (Underlining represents text that was added, and brackets represent text that was removed.) Red text illustrates the successive narrowing of the port-shape limitation, and yellow highlighting further emphasizes the correlation between the port-shape limitation of original claim 1 and the elliptical port-shape limitation of issued claim 1.

Amendment A to Original Claim 1:

the region outside said enclosure having a smoothly flared input end within said inside volume and a smoothly flared output end adjacent to the region outside said inside volume, wherein said at least one port has a lengthwise axis, said at least one port being symmetrical about said lengthwise axis, the entire perimeter of both said input and said output end being smoothly flared.

[Pet. App. 79a, 102a (amendment made in response to § 102 rejection based on Todisco and Laupman)].

Amendment C to Original Claim 1:

the region outside said enclosure having a smoothly flared input end within said inside volume and a smoothly flared output end adjacent to the region outside said inside volume, wherein said at least one port has a lengthwise axis, said at least one port being symmetrical about said lengthwise axis, the entire perimeter of both said input end and said output end being smoothly flared.

[Pet. App. 79a, 102a (amendment made in response to § 102 rejection based on Todisco and Laupman)].

Amendment D to Original Claim 1:

the region outside said enclosure having a smoothly flared input end within said inside volume and a smoothly flared output end adjacent to the region outside said inside volume, wherein said at least one port has a lengthwise axis, said at least one port being symmetrical about said lengthwise axis, the entire perimeter

of both said input end and said output end being smoothly flared with the cross-sectional area of said at least one port progressively decreasing from both said input end and said output end toward the center of said at least one port for substantially the distance between said input end and said center and substantially the distance between said output end and said center.

[Pet. App. 80a, 103a (amendment made in response to § 102 rejection based on Furukawa)].

Amendment E to Original Claim 1:

the region outside said enclosure having a smoothly flared input end within said inside volume and a smoothly flared output end adjacent to the region outside said inside volume, wherein said at least one port has a lengthwise axis, said at least one port being symmetrical about said lengthwise axis, the entire perimeter of both said input end and said output end being smoothly flared with the cross-sectional area of said at least one port progressively decreasing from both said input end and said output end toward [the center of] a minimum inside said at least one port for substantially the entire distance between said input end and said [center] minimum and substantially the entire distance between said output end and said [center] minimum.

[Pet. App. 81a, 103a (amendment made in response § 102 rejection based on Furukawa and Schreiber, et al.)].

Amendment F to Original Claim 1:

> the region outside said enclosure having a smoothly flared input end within said inside volume and a smoothly flared output end adjacent to the region outside said inside volume, wherein said at least one port has a lengthwise axis, said at least one port being symmetrical about said lengthwise axis, the entire perimeter of both said input end and said output end being smoothly flared with the cross-sectional area of said at least one port progressively decreasing from both said input end and said output end toward a plane of minimum cross-sectional area inside said at least one port for substantially the distance between said input end and said plane of minimum cross-sectional area and substantially the distance between said output end and said plane of minimum cross-sectional area.

[Pet. App. 81a-82a, 104a (amendment made in response to § 102 rejection based on Furukawa and Schreiber, et al.)].

Despite making these five progressively narrowing amendments in an attempt to overcome the prior art rejections, Bose failed to obtain allowance of original claim 1. At this point, Bose surrendered original claim 1 by canceling that claim and rewriting original dependent claim 2 in independent form:

Amendment G to Original Claim 1:

> Please cancel claim 1.

[Pet. App. 82a (response to § 102 rejection based on Furukawa and Schreiber, et al.)].

Claim 2 Rewritten in Independent Form in Amendment A:

> the region outside said enclosure having a smoothly flared input end within said inside volume and a smoothly flared output end adjacent to the region outside said inside volume, wherein said port defines a boundary between the acoustic mass therein and said inside volume, said boundary being defined by an ellipse.

[Pet. App. 82a (independent claim 2 allowed subject to subsequent § 112, ¶ 2 rejection)].

Thus, after five unsuccessful attempts to obtain allowance of original claim 1, Bose essentially made a sixth narrowing amendment by canceling original claim 1 and rewriting original claim 2 in independent form.

In its Opposition, Bose completely ignores these six narrowing amendments. Instead, Bose addresses only the "having a major diameter" amendment, which Bose made later in prosecution in response to a rejection under 35 U.S.C. § 112, ¶ 2.

Only after making *all* of these amendments (both the "having a major diameter" amendment *and* the previous six narrowing amendments to the same port-shape limitation) was Bose able to obtain allowance of the '721 patent. Accordingly, *all* of these amendments—not just the one amendment that Bose chooses to acknowledge—affect the equivalent scope of the '721 patent claims.

II. ESTOPPEL APPLIES EVEN IF ORIGINAL CLAIM 2 ITSELF WAS NOT SUBSTANTIVELY AMENDED

Bose's assertion that there can be no estoppel because Bose did not narrow original claim 2 during prosecution

also is wrong. The Federal Circuit has consistently rejected this argument as exalting form over substance and because it is in conflict with clear precedent. *See Haynes Int'l v. Jessop Steel Co.*, 8 F.3d 1573, 1579 (Fed. Cir. 1993).

The cancellation of a claim can and does give rise to prosecution history estoppel. *See Haynes Int'l*, 8 F.3d at 1578-79, *as clarified*, 15 F.3d 1076 (Fed. Cir. 1994) (prosecution history estoppel applies when an applicant relinquishes claim scope by canceling broad rejected claims in favor of a narrower allowed claim); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 681 (Fed. Cir. 1988) (Even where an issued claimed was not substantively amended, but was initially dependent on a broader claim which was rejected and cancelled, the originally dependent claim cannot be later interpreted under the doctrine of equivalents to cover the subject matter of the rejected and cancelled independent claim).

In support of its assertion that rewriting original claim 2 did not give rise to prosecution history estoppel, Bose presents the same argument made by the United States in the *Festo* case. (Opp. Br. pp. 9-10). However, Bose fails to point out that the Court explicitly *rejected* this argument in the *Festo* decision:

> The PTO might require the applicant . . . to rewrite a dependent claim as an independent one. In these cases, petitioner argues, the applicant has no intention of surrendering subject matter and should not be estopped from challenging equivalent devices. *While this may be true in some cases*, petitioner's argument conflates the patentee's reason for making the amendment with the

> impact the amendment has on the subject matter.
>
> Estoppel arises when an amendment is made to secure the patent and the amendment narrows the *patent's* scope.
>
> * * *
>
> While the patentee has a right to appeal [a claim rejection], his decision to forego appeal and submit an amended claim is taken as a concession that the invention as patented does not reach as far as the original claim.

Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 122 S. Ct. 1831, 1840, 1833 (2002).

Because Bose cancelled original claim 1 and rewrote original claim 2 in independent form *for the purpose of securing issuance of the '721 patent*, prosecution history estoppel presumptively applies in this case. "A patentee's decision *to narrow his claims* through amendment may be presumed to be a general disclaimer of the territory between the original claim and the amended claim." *Id.* at 1842 (emphasis added). The accused loudspeaker ports in the instant case fall within this territory. Therefore, prosecution history estoppel presumptively prevents coverage of those ports under the doctrine of equivalents. *See id.*

Bose's rewriting of claim 2 in independent form is no different than if Bose had directly amended claim 1 a sixth time by incorporating the elliptical port-shape limitation of claim 2 into claim 1. Prosecution history estoppel applies equally in either case. To hold otherwise truly exalts form over substance.

CONCLUSION

Bose repeatedly amended the claim limitation at issue to obtain allowance of the '721 patent. *Festo* places the burden on Bose to show that it did not surrender the accused port shape by these amendments. However, the Federal Circuit did not address the effect of Bose's narrowing amendments on the scope of equivalents, if any, to which Bose was entitled. Accordingly, JBL respectfully requests consideration by this Court or vacation and remand of this matter to the Federal Circuit.

Respectfully submitted,

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